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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/918,754	07/30/2001	Gopal N. Iyer	60027.0027US01/BS00045	2738
23552	7590	01/10/2005	EXAMINER	
MERCHANT & GOULD PC P.O. BOX 2903 MINNEAPOLIS, MN 55402-0903			LY, NGHI H	
			ART UNIT	PAPER NUMBER
			2686	

DATE MAILED: 01/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/918,754

Applicant(s)

IYER ET AL.

Examiner

Nghi H. Ly

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 5-12 is/are rejected.
- 7) ☒ Claim(s) 2-4 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 5, 6, 8 and 9 are rejected under 35 U.S.C. 102(e) as being anticipated by Vainiomaki et al (US 6,529,732).

Regarding claims 1, 5 and 8, Vainiomaki teaches a method of reconciling first format receiver transfer data with second format receiver transfer data comprising: comparing a first format entry of the first format receiver transfer data to a second format entry of the second format receiver transfer data (see abstract and see column 5, line 15 to column 6 line 11), and automatically modifying the first format entry if receiver transfer data of the second format entry is not included in first format entry (also see abstract and see column 8, lines 20-lines 50).

Regarding claim 6, Vainiomaki further teaches determining if the first directed retry list does not include an available cell face identifier of the second directed retry list; and adding the available cell face identifier of the second directed retry list to the first directed retry list if the available cell face identifier is not included in the first directed retry list (see column 2, lines 8-12 and see column 5, line 15 to column 6 line 11, in

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order to know a different standard or format between two networks, the teaching of Vainiomaki inherently teaches the retry list).

Regarding claim 9, Vainiomaki further teaches the cell face transfer data is in one of a plurality of Directed Retry List forms (see column 2, lines 8-12).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 7 and 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vainiomaki et al (US 6,529,732) in view of Tanaka et al (US 5,335,355).

Regarding claim 7, Vainiomaki teaches the first directed retry list (see column 2, lines 8-12 and see column 5, line 15 to column 6 line 11, in order to know a different standard or format between two networks, the teaching of Vainiomaki inherently teaches the retry list).

Vainiomaki does not specifically disclose retry list is a Reselection List form and the second directed retry list is a Cell Equipage Face form and the step of adding comprises a step of: replacing a no indicator with a yes indicator in the Reselection List form.

Tanaka teaches a Reselection List form and the second directed retry list is a Cell Equipage Face form and the step of adding comprises a step of: replacing a no indicator with a yes indicator in the Reselection List form (see column 2, lines 34-68, see "digital").

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Tanaka into the system of the Vainiomaki in order to provide a cellular radio communication system which is capable of selectively using either analog mode or digital mode when exchanging radio communication between a base station and a mobile station apparatus (see Tanaka, column 1, lines 11-16).

Regarding claim 10, Vainiomaki teaches claims 9 and 10. Vainiomaki does not specifically disclose the first format is Cell Equipage Face format.

Tanaka further teaches the first format is Cell Equipage Face format (see column 2, lines 34-68, see "analog").

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Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Tanaka into the system of the Vainiomaki in order to provide a cellular radio communication system which is capable of selectively using either analog mode or digital mode when exchanging radio communication between a base station and a mobile station apparatus (see Tanaka, column 1, lines 11-16).

Regarding claim 11, Vainiomaki teaches claims 9 and 10. Vainiomaki does not specifically disclose the second format is Reselection format.

Tanaka further teaches the second format is Reselection format (see column 2, lines 34-68, see "digital").

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Tanaka into the system of the Vainiomaki in order to provide a cellular radio communication system which is capable of selectively using either analog mode or digital mode when exchanging radio communication between a base station and a mobile station apparatus (see Tanaka, column 1, lines 11-16).

Regarding claim 12, Vainiomaki teaches claims 9 and 10. Vainiomaki does not specifically disclose the first cell site data includes a cell site identifier having one or more associated cell face identifiers.

Tanaka further teaches the first cell site data includes a cell site identifier having one or more associated cell face identifiers (see Tanaka, column 7, lines 26-35).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Tanaka into the system of the Vainiomaki in order to provide a cellular radio communication system which is capable of selectively using either analog mode or digital mode when exchanging radio communication between a base station and a mobile station apparatus (see Tanaka, column 1, lines 11-16).

Allowable Subject Matter

6. Claims 2-4 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 2-4 are objected for the reasons as indicated in the previous Office action dated 01/18/2004.

Response to Arguments

7. Applicant's arguments filed 08/20/2004 have been fully considered but they are not persuasive.

On page 6 of applicant's remarks, applicant argues that Vainiomaki does not compare or modify any cell receiver transfer data.

The examiner, however, disagrees. Vainiomaki teaches "converted", "conversion", "updating and conversion" or "converting" (see Abstract and column 5, line 60 to column 6, line 11) and it/they reads on Applicant's "modify", and Vainiomaki teaches "respective data" or "service" (see Abstract) and it reads on applicant's

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“receiver transfer data”. In addition, Applicant’s claims 1, 5 and 8 fail to further defined what a “receiver transfer data” is. Therefore, Vainiomaki indeed teaches Applicant’s claimed limitation with the broadest reasonable interpretation. In addition, Applicant’s attention is directed to the rejection of claims 1, 5 and 8 in the previous Office Action dated 08/20/2004.

On page 7 of applicant’s remarks, applicant further argues that the combination of Vainiomaki and Tanaka does not teach comparison or modification of cell receiver transfer data, in particular, the comparison and modification of data in a directed retry list of a Cell Equipage Face form or a Reselection List form, and there is no motivation to combine the references.

In response, Vainiomaki teaches comparison or modification of cell receiver transfer data (see Examiner’s answer above), and Tanaka teaches “digital” and “analog” (see column 2, lines 34-68) and they read on Applicant’s “a Cell Equipage Face form” or “a Reselection List form”. In addition, Applicant’s claims fail to further defined what a “Cell Equipage Face form” or “a Reselection List form” is. Therefore, Tanaka indeed teaches Applicant’s claimed limitation with the broadest reasonable interpretation and the combination of Vainiomaki and Tanaka does indeed teach Applicant’s invention.

In response to Applicant’s argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in

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the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation to do so found in the references themselves in order to provide a cellular radio communication system which is capable of selectively using either analog mode or digital mode when exchanging radio communication between a base station and a mobile station apparatus (see Tanaka, column 1, lines 11-16).

On page 7 of Applicant's remarks, Applicant further argues that Tanaka does not disclose cell transfer data used in the process of selecting and switching cell faces for cellular calls.

In response to Applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., cell transfer data) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

On page 8 of Applicant's remarks, Applicant further argues that the combination of Vainiomaki and Tanaka does not disclose all the claim limitations in the present invention.

In response, the combination of Vainiomaki and Tanaka does indeed teach Applicant's claimed invention. In addition, Applicant's attention is directed to the rejection of claims 1 and 5-12 above.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nghi H. Ly whose telephone number is (703) 605-5164. The examiner can normally be reached on 8:30 am-5:30 pm Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold can be reached on (703) 305-4379. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

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Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nghi H. Ly

NH Ly
01/05/05

Marsha D Banks-Harold
MARSHA D. BANKS-HAROLD
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600